

REMARKS

This Application has been carefully reviewed in light of the final Office Action mailed January 26, 2004 (the "Office Action") and the Advisory Action mailed May 5, 2004 (the "Advisory Action"). The Examiner rejects Claims 16-30. In order to advance prosecution of this case, Applicant amends Claims 16, 19, 20, and 22, cancels Claims 17 and 21 without prejudice or disclaimer and adds new Claims 31 and 32. Applicant respectfully requests reconsideration and favorable action in this case.

Section 102 Rejections

The Office Action rejects Claims 16-22 and 24-26 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,574,018 to Handelman ("*Handelman*"). Applicant respectfully traverses these rejections for the reasons discussed below.

To anticipate a claim, each and every limitation must be found in a reference. In addition, "[t]he identical invention must be shown in as complete detail as is contained in the ... claims" and "[t]he elements must be arranged as required by the claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 USPQ 2d 1566 (Fed. Cir. 1990); MPEP § 2131 (*emphasis added*).

Claim 16 recites a first optical channel space defined by a passband of a first filter, a second optical channel space defined by a passband of a second filter and a new optical space defined by an increased passband of the first filter. *Handelman* does not disclose, teach or suggest these elements. The Office Action reads *Handelman* as disclosing a filter with a passband that defines a new channel space. However, there is no cited disclosure for a passband of a first filter defining a first optical channel space, a passband of a second filter defining a second optical channel space and an increased passband of the first filter defining a new optical channel space. Therefore, for at least the reasons stated above, Applicant respectfully submits that Claim 16 is patentable over the cited art and request that the rejection of Claim 16 be withdrawn.

Claims 17 and 18 depend from Claim 16 and therefore include all elements of Claim 16. Applicant thus respectfully requests that the rejection of Claims 17 and 18 be withdrawn because, as discussed above, *Handelman* does not disclose, teach or suggest every element of Claim 16.

Claim 19 recites a first optical channel space defined by a passband of a first tunable filter, a second optical channel space defined by a passband of a second tunable filter and a new optical space defined by an increased passband of the second filter. *Handelman* does not disclose, teach or suggest these elements for similar reasons as discussed above with respect to Claim 16. Therefore, Applicant respectfully submits that Claim 19 is patentable over the cited art and request that the rejection of Claim 19 be withdrawn.

Claim 20 recites a first optical channel space defined by a passband of a first filter, a second optical channel space defined by a decreased passband of the first filter and a third optical space defined by a passband of a second filter. *Handelman* does not disclose, teach or suggest these elements. The Office Action reads *Handelman* as disclosing a filter with a passband that defines a channel space. However, there is no cited disclosure for a passband of a first filter defining a first optical channel space, a decreased passband of the first filter defining a second optical channel space and a passband of a second filter defining a third optical channel space. Therefore, for at least the reasons stated above, Applicant respectfully submits that Claim 20 is patentable over the cited art and request that the rejection of Claim 20 be withdrawn.

Claim 21 depends from Claim 20 and therefore includes all elements of Claim 20. Applicant thus respectfully requests that the rejection of Claim 21 be withdrawn because, as discussed above, *Handelman* does not disclose, teach or suggest every element of Claim 20.

Claim 22 recites a first optical channel space defined by a passband of a first tunable filter, a second optical channel space defined by a decreased passband of the first tunable filter and a third optical space defined by a passband of a second tunable filter. *Handelman* does not disclose, teach or suggest these elements. *Handelman* does not disclose, teach or

suggest these elements for similar reasons as discussed above with respect to Claim 20. Therefore, Applicant respectfully submits that Claim 22 is patentable over the cited art and request that the rejection of Claim 22 be withdrawn.

Section 103 Rejections

The Office Action rejects Claims 23 and 27-30 as unpatentable over *Handelman*. Applicant respectfully traverses this rejection for the reasons discussed below.

In order to establish a prima facie case of obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *See In re Royka*, 409 F.2d 981 (CCPA 1974).

Claim 23 recites a plurality of passband filters, each "operable to vary the initial spectrum width of at least one of the initial channels to form at least one new channel that utilizes a channel spacing of at least one of the initial channels." The Office Action fails to address Applicant's previous argument that mere duplication of the passband filter of *Handelman* would not anticipate the elements of Claim 23. For example, Claim 23 recites a plurality of passband filters each operable to vary the initial spectrum width of at least one of the initial channels to form at least one new channel that utilizes a channel spacing of at least one of the initial channels. Mere duplication of the filter of *Handelman* would not accomplish this element because there is no disclosure in *Handelman* of varying a spectrum width of an initial channel to create a new channel to utilize a channel spacing of the initial channel. Moreover, there is no cited suggestion or motivation in *Handelman* or any other cited art to duplicate the passband filters. The Office Action refers to a "variable nature" of the system of *Handelman*, but still provides no specific support for duplicating the passband filters. *See* Office Action, page 9. Furthermore, the Board of Patent Appeals and Interferences has indicated that *St. Regis*, relied upon in the previous rejection of Claim 23, is "heavily fact dependent" in reversing a previous over-reliance upon the thinking processes of the *St. Regis* court. *See Ex Parte Yutaka Urino and Tomoki Saito*, 1996 WL 1748823 (Bd.Pat.App & Interf.); *see also Ex Parte Edward H. Nortrup*, 1996 WL 1749314

(Bd.Pat.App & Interf.). Applicant thus respectfully submits that Claim 23 is nonobvious over the disclosure of *Handelman* and request allowance of Claim 23.

Claim 24 depends from Claim 16 and therefore includes all elements of Claim 16. Applicant thus respectfully requests that the rejection of Claim 24 be withdrawn because, as discussed above, *Handelman* does not disclose, teach or suggest every element of Claim 16.

Claims 25 and 26 depend from Claim 19 and therefore include all elements of Claim 19. Applicant thus respectfully requests that the rejection of Claims 25 and 26 be withdrawn because, as discussed above, *Handelman* does not disclose, teach or suggest every element of Claim 19.

Claims 27 and 28 depend from Claim 20 and therefore include all elements of Claim 20. Applicant thus respectfully requests that the rejection of Claims 27 and 28 be withdrawn because, as discussed above, *Handelman* does not disclose, teach or suggest every element of Claim 20.

Claims 29 and 30 depend from Claim 22 and therefore include all elements of Claim 22. Applicant thus respectfully requests that the rejection of Claims 29 and 30 be withdrawn because, as discussed above, *Handelman* does not disclose, teach or suggest every element of Claim 22.

New Claims

Applicant adds new Claims 31 and 32. Claims 31 and 32 contain no new matter and are fully supported by the specification as filed. Applicant respectfully submits that Claims 31 and 32 are allowable over the art. For example, the cited art used in the rejections does not disclose, teach or suggest each element of Claims 31 and 32. Therefore, Applicant respectfully requests allowance of Claims 31 and 32.

ATTORNEY DOCKET NO.
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CONCLUSIONS

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending claims.

If the present application is not allowed and/or if one or more of the rejections is maintained, Applicant hereby requests a telephone conference with the Examiner and further requests that the Examiner contact the undersigned attorney to schedule the telephone conference.

No fee is believed to be due. However, the Commissioner is hereby authorized to charge any fees to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
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Date: May 26, 2004

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